ESTTA Tracking number: **ESTTA641387**

Filing date: **11/26/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91211873
Party	Plaintiff Green Ivy Educational Consulting, LLC
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Date	11/26/2014
Attachments	memo.pdf(780452 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GREEN IVY EDUCATIONAL CONSULTING, LLC,	:	
Opposer,	:	Opposition No. 91211873
-against-	:	Serial Nos.: 85775379, 85775380 and 85775382
GREEN IVY HOLDINGS LLC,	:	
Applicant.	:	Marks: GREEN IVY, GREEN IVY SCHOOLS and GREEN IVY LEARNING

OPPOSERS' MEMORANDUM IN SUPPORT OF ITS MOTION FOR RECONSIDERATION

Green Ivy Educational Consulting, LLC ("Opposer" or "GIEC"), submits this memorandum in support of its motion, pursuant to 37 C.F.R. §127(b) for reconsideration of its motion under 37 C.F.R. § 2.127 and Rule 56 of the Federal Rules of Civil Procedure ("FRCP") for summary judgment in favor of Opposer refusing registration of GREEN IVY, Serial No. 85775379, GREEN IVY SCHOOLS, Serial No. 85775380, and GREEN IVY LEARNING, Serial No. 85775382 (collectively, the "Marks Under Application"), filed by Green Ivy Holdings LLC ("GIH" or "Applicant").

PRELIMINARY STATEMENT

In its November 5, 2014 order denying GIEC's motion for summary judgment, the Board did not identify any specific evidence set forth by Applicant that gives rise to a material issue of fact. Rather, the Board simply stated that GIEC did not meet its burden and that "there exists a genuine dispute as to the nature of Opposer's tutoring services and educational programs; the degree of relatedness between Opposer's various educational services and those of Applicant; and the date when Opposer began to offer each of its educational services in connection with the GREEN IVY mark." In support, the Board points solely to the lack of indisputable documentary

evidence regarding the use of GREEN IVY in connection with all relevant services on a date prior to the filing date of the oppose applications.

Opposer submits that Applicant did not raise any meaningful dispute regarding the seniority of use of GREEN IVY by GIEC and that the affidavit itself, which constitutes admissible evidence for purposes of summary judgment, provided sufficient proof of the seniority for GIEC's use. Moreover, given the marks at issue are identical – other than descriptive matter – the nature of the clearly educational services was sufficiently outlined and clearly sufficiently proximate to the services to be offered by GIH that no material issue of fact can be said to remain.

FACTS

GIEC notes the following key facts in the record:

- In March 2004, GIEC began using both GREEN IVY and GREEN IVY EDUCATIONAL CONSULTING in its work with "elementary and secondary school students during school hours and after school *to provide tutoring and learning support services*…." Homayoun Decl. ¶¶ 8-9 (emphasis added); see also, e.g., Barsky Declaration Exhibit A ("Homayoun Dep. Tr.") 23:22-24; 37:2-12 (July 23, 2014).

- Since 2009, GIEC has published an e-newsletter under the mark GREEN IVY to provide a resource with advice for parents, educators and administrators, including information on education, schools, and professional development. See Homayoun Decl. ¶¶ 17.

- Since 2010, GIEC has consulted with educators on a variety of education and parenting topics, developed curricula and consulted with schools on curriculum development. See Homayoun Decl. ¶¶ 14; see also, e.g., Homayoun Dep. Tr. 21:24-22:22.

ARGUMENT

I. SUMMARY JUDGMENT SHOULD HAVE BEEN GRANTED

Based on the facts before it and the applicable law, summaru judgment should have been granted for the Opposer.

A. GIEC Met Its Burden There Are No Disputed Material Issues of Fact

GIEC has presented uncontroverted evidence that meets its burden of establishing the elements of its claim under 15 U.S.C. § 1052(d); and *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001), namely that Opposer has standing, priority of use and there is a likelihood of confusion between Opposer's marks and the marks applied for by Applicant.

1. Standing

GIEC's standing has not been seriously challenged. The Board did not suggest there was any genuine issue of fact regarding GIEC's standing, nor could there be. GIEC has been using both GREEN IVY and GREEN IVY EDUCATIONAL CONSULTING since it adopted the marks in March 2004. Even if it was using the marks solely as a trade name, which GIEC does not concede, it has standing to challenge the application for nationwide exclusive rights filed by GIH, since the grant of a registration could negatively impact GIEC's rights.

2. Priority of Use

As Ms. Homayoun's Declaration and the transcript submitted by Applicant with its opposition to the motion for summary judgment establish, GIEC began using GREEN IVY and GREEN IVY EDUCATIONAL CONSULTANTS in commerce 2004 in connection with tutoring services, at least as early as 2009 in connection with a newsletter and in 2010 in connection with consulting services and curriculum development for educators and schools. All these uses are undoubtedly prior to Applicant's November 9, 2012 filing date. Indeed, Applicant

admitted that to the extent Opposer used GREEN IVY in 2004, this is before Applicant's first use of its GREEN IVY mark. Applicant only questioned whether GREEN IVY or GREEN IVY EDUCATIONAL SERVICES is the mark used by Opposer. However, in either event, "green ivy" is the dominant portion, and there was clearly use in one form or the other, or both. In light of this, which one is immaterial.

The Board does not identify any dispute over whether Opposer is the senior user at all, but rather, indicates that there is a dispute as to the date when Opposer began to offer "each of its educational services," and notes that the documentary evidence does not "demonstrate beyond dispute that its mark was use in connection with *all of the relevant services* on a date prior to the filing date of the opposed application." (Opinion at 3). However, GIEC had no obligation to prove use of *all the services* prior to the date of Applicant's filing, *only one* that is related to the services proposed to be offered by Applicant sufficient to establish a likelihood of confusion. As noted by the Supreme Court in *Anderson v. Liberty Lobby*, 477 U.S 242, 248 (1986), the summary judgment standard under Rule 56(c) of Federal Rules of Civil Procedure "provides that the mere existence of *some* alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no genuine issue of *material* fact." Thus, even if it is in dispute whether all Opposer's services were offered before 2012, Opposer has still met its burden since it has proven that the mark was in use in connection with some service that could support the claim, as it was here.

Moreover, Opposer need not present any documentary evidence regarding at all. Under Federal Rule of Civil Procedure 56(c), summary judgment is proper "if the pleadings, depositions, answers to interrogatories, and admissions on file, *together with the affidavits*, if any, show that there is no genuine issue as to any material fact and that the moving party is

entitled to a judgment as a matter of law." (Emphasis added.) The exhibits have been submitted simply as examples in addition to the sworn testimony of Ms. Homayoun, which is, on its own, sufficient for a grant of summary judgment. Ms. Homayoun, submitted her declaration on personal knowledge and as the founder and CEO of GIEC is clearly in a position to know when GIEC commenced use of the mark. Her declaration is sufficient to establish this fact, as is her sworn testimony, which was put into the record by Applicant.

GIEC thus established that it began offering tutoring (in 2004), newsletters with information on education, schools, and professional development (in 2009), and consulting on curriculum development (in 2010), all prior to Applicant's filing date. Homayound Decl. ¶¶ 8-9, 14, 17.

3. Likelihood of Confusion

The Board looks at the factors under *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Applicant did not even address the majority of the factors in its briefing, and the only DuPont factor the Board clearly identifies as the subject of dispute is the relatedness of the services.

Applicant submits that there is ample uncontroverted evidence in the record that, particularly in light of the conceptual strength of the dominant element of all marks issue – GREEN IVY – the services are sufficiently related to establish a likelihood of confusion.[1]

Ms. Homayoun provided testimony that GIEC provides tutoring and consulting services. Indeed Applicant acknowledged that GIEC provides these services. *See, e.g.*, Applicant's Response in Opposition to Opposer's Motion for Sanctions and For Summary Judgment

[1] Applicant did not contest the conceptual strength of the GREEN IVY mark, the channels of trade, or the similarity of the marks. All these factors should thus have been deemed admitted and weighed in favor of GIEC.

("Opp.") Sect. III(e) (July 23, 2014) (acknowledging evidence shows GIEC provides tutoring and consulting services).

Nonetheless, the Board still questioned "the nature" of GIEC's tutoring services and whether GIEC's services are related to Applicant's services. The nature of "tutoring" is clear on its face. Moreover, the Board can take judicial notice of the very dictionary definition of tutoring. TBMP §704.12; Fed. Rule Evid. 201(b); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1515 (TTAB 2009). According to dictionary definitions "tutor" means "to teach a single student," or "to act as a tutor to; teach or instruct, especially privately" See Merriam-Webster.com. 2014. http://www.merriam-webster.com (24 November 2014); Dictionary.com 2014 http://dictionary.reference.com/ (24 November 2014). Thus, it is clear that GIEC teaches or instructs students.[2]

With regard to the relatedness of the services, Applicant acknowledges that it is "undisputed" that "Applicant seeks registration for, *inter alia*, "curriculum development" and "before and after school educational and enrichment programs." It cannot seriously be disputed that "curriculum development" claimed to be intended by GIN is related to curriculum development, which evidence shows GIEC has offered since 2010.

Likewise, it cannot seriously be disputed – and GIH has not – that "before and after school educational and enrichment programs" are related to tutoring, which seeks to assist with student learning and the ability of students to learn and perform in various academic subjects. Indeed, Ms. Homayoun specifically noted "Since its inception, GIEC has worked with elementary and secondary school students during school hours and after school to provide

[2] When the Homayoun transcript and Declaration are taken as a whole there is simply no question that the tutoring is educational in nature and aimed at aiding student performance in school. To the extent that the assistance provided relates to planning and organizational techniques, it is still clear that the focus in on applying these techniques to homework and school. *See generally* Homayoun Decl.

tutoring and learning support services and programs focused on helping students improve their academic performance." Homayoun Decl. ¶9.

It is not Opposer's burden to prove that the services it offers and those intended by Applicant overlap, rather, "it is sufficient that the respective goods of the parties be related *in some manner*, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or *could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source*." *See Hilson Research, Inc. v. Society for Human Resource Mgmt.*, 27 U.S.P.Q. 2d 1423 (TTAB 1993) (citation omitted) (emphasis added); *In re Int'l Telephone & Telegraph Corp.*, 197 U.S.P.Q. 910 (TTAB 1978). The "degree of relatedness" necessary for a finding of likelihood of confusion was thus clearly met, particularly where there is no dispute regarding the channels of trade, which include targeting parents of school children.

GIH admits that GIEC provides "consultant" services – akin to Applicant's "curriculum development" – as it must given the evidence in the record. Opp. Sect. III(e); *see also, e.g.*, Homayoun Decl. ¶¶ 11, 14, 22 (discussing GIEC's consulting services); Homayoun Dep. Tr. 22:7-11 ("We perform curriculum development in schools, so schools hire us, and we help then with organization, time management and a wide range of curriculum development").

There is simply no meaningful basis to differentiate Opposer's tutoring and consulting services from the Applicant's before and after school enrichment services or consulting and curriculum development services. There can thus be no genuine dispute about the degree of relatedness of the services.

CONCLUSION

For the foregoing reasons, summary judgment should have been granted and GIEC' requests reconsideration of the denial of summary judgment.

Dated: November 25, 2014
New York, New York

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CERTIFICATE OF SERVICE

I hereby certify on this 26th day of November 2014, I caused to be served a true and correct copy of the foregoing OPPOSERS' MEMORANDUM IN SUPPORT OF ITS MOTION FOR RECONSIDERATION via U.S. first class mail, postage prepaid, on the following:

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